

REMARKS

Applicants acknowledge receipt of the Examiner's Office Action dated November 27, 2007.

Claims 1-38 are pending in the application.

Claims 1-38 have been rejected.

Claims 1, 9, 17, 23, 26, 28 and 35 have been amended.

Claims 8, 10, 25 and 31-32 have been cancelled.

Claim Objections

Claim 25 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 24.

Applicants have cancelled claim 25, thus addressing the Examiner's concerns.

Rejection of Claims under 35 U.S.C. § 102

Claims 1-7, 12-30, and 33-38 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over Hack et al., U.S. Publication No. 2003/0187675 (Hack).

While not conceding that the cited reference qualifies as prior art, but instead to expedite prosecution, Applicants have chosen to respectfully traverse the rejection, in light of the amendments made. Applicants reserve the right, for example, in a continuing application, to establish that the cited reference, or other references cited now or hereafter, do not qualify as prior art as to an invention embodiment previously, currently, or subsequently claimed.

Applicants therefore respectfully submit that amended independent claims 1, 17, 23, 26, 28 and 35 overcome the instant rejection, as do claims depending thereon.

Rejection of Claims under 35 U.S.C. § 103

Claims 8, 9, and 31 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hack in view of SAP.com, 2002 (SAP.com). Claims 10, 11, and 32 are rejected under 35 U.S.C. § being unpatentable over Hack as applied to claims 1 and 28 above in view of Spangenberg et al., U.S. Publication No. 2004/0260585 (Spangenberg).

While not conceding that the cited references qualify as prior art, but instead to expedite prosecution, Applicants have chosen to respectfully disagree and traverse the rejection as follows. Applicants reserve the right, for example, in a continuing application, to establish that the cited references, or other references cited now or hereafter, do not qualify as prior art as to an invention embodiment previously, currently, or subsequently claimed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. In teaching or suggestion to make the claimed combination and the reasonable expectation of success, must both be found in the prior art and not based on Applicants' disclosure. The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is

directed to obvious subject matter, either the references must expressly or impliedly suggest that the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. MPEP 2142.

Applicants have amended independent claims 1, 17, 23, 26, 28 and 35 in the manner of claim 1, which now reads as follows:

1. A method comprising:
receiving user-specified information pertaining to one or more business challenges of an organization;
identifying one or more predefined business processes that address the one or more business challenges of the organization;
estimating benefits that are to be gained by the organization when the one or more business challenges are successfully addressed;
communicating the estimated benefits to the user;
recommending the one or more predefined business processes to a user; and
assessing an adoption level of an automated technology by the organization based on the one or more business challenges and the industry and revenue data.

As also noted, Applicants respectfully note that independent claims 17, 23, 26, 28 and 35 have been amended to recite, among other limitations, substantially similar limitations to those presented above.

In order for a claim to be rendered invalid under 35 U.S.C. § 103, the subject matter of the claim as a whole would have to be obvious to a person of ordinary skill in the art at the time the invention was made. *See* 35 U.S.C. § 103(a). This requires that: (1) the references teach or suggest all of the claim limitations; (2) there must be some teaching, suggestion or motivation to combine references either in the references themselves or in the knowledge of the art; and (3) there must be a reasonable expectation of success. *See* MPEP 2143; MPEP 2143.03; *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

By contrast to the claimed invention, Hack is directed to:

“A strategic management tool that calculates a business value. The tool selects at least one relevant business process, presents key performance indicators associated with the relevant business process, and derives a value equation based on a subset of key performance indicators.” (Hack; Abstract)

With regard to claims 8, 9, and 31, the Office Action further cites SAP.com, stating that:

“As per claim 8, Hack et al. discloses all of the elements of the claimed invention but fails to explicitly disclose ‘assessing an adoption level of an automated technology by the organization based on the one or more business challenges and the industry and revenue data’.

SAP.com discloses a value calculator that ‘accesses an adoption level of an automated technology by the organization based on the one or more business challenges and the industry and revenue data’ (SAP Value Calculators; 2 and 3; via value calculators determine your ‘stage of excellence’ by assessing your company’s industry, financial performance, and e-business maturity information and also calculates how much additional value you can realize by improving your e-business infrastructure, where the e-business would be improving the infrastructure by using one of SAP’s automated technologies).

Therefore it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the business process valuation tool of Hack et al. to include the value calculator as taught by SAP because it would provide another way for the user to determine the best process to implement in their company.” (Office Action; pp. 11-12, section 6)

Applicants agree that, among other infirmities, Hack fails to show, teach or suggest assessing an adoption level of an automated technology by the organization based on the one or more business challenges and the industry and revenue data, as correctly noted in the Office Action. However, Applicants respectfully disagree with the position that SAP.com cures this infirmity.

The document cited as SAP.com fails to provide any teachings as to the performance of the claimed assessing. A parallel between the statement in SAP.com that the calculators discussed therein can be used for “... assessing [a] ... company’s industry, financial performance, and e-business maturity information ...,” and the claimed “assessing an adoption

level of an automated technology by the organization based on the one or more business challenges and the industry and revenue data . . .,” cannot be successfully drawn. This is at least because what is being assessed in SAP.com is a company’s industry, financial performance, and e-business maturity information, while the claimed invention assesses an adoption level of an automated technology by the organization. Nothing even comparable to the claimed adoption level of an automated technology by the organization is shown, taught or suggested by anything in SAP.com.

Moreover, SAP.com fails to provide any teachings as to *how* one of skill in the art might practice anything that *is* shown, taught or suggested therein. In fact, by citing a web site, the Office Action indicates as much. There is no showing, teaching or suggestion of how one of skill in the art might implement such calculators (even if such calculators were even comparable to any aspect of the claimed invention, which Applicants maintain is not the case). A person, albeit misguided, attempting to marry the system disclosed in Hack and that of SAP.com would find nothing in the document cited as SAP.com that would enable one of skill in the art to practice anything that might be disclosed therein.

Furthermore, neither Hack nor SAP.com provide any reason to combine their disclosures (such as they are). One of skill in the art would find nothing in either document that would lead them to the conclusion that their disclosure should be combined, as discussed subsequently.

With regard to claims 10, 11 and 32, the Office Action cites Spangenberg, which is directed to:

“A method and apparatus for measuring a benefit of business improvements. Actual performance information of a business is collected and

stored in a storage device. The actual performance information is compared to estimated performance information prior to implementation of the business improvement. The benefit of the business improvement may then be measured by comparing the actual performance information to the estimated performance information.” (Spangenberg; Abstract)

Applicants agree that, among other infirmities, Hack fails to show, teach or suggest estimating benefits that are to be gained by the organization when the one or more business challenges are successfully addressed, or communicating the estimated benefits to the user, as correctly noted in the Office Action. However, Applicants respectfully disagree with the position that Spangenberg cures this infirmity.

The Office Action states that the following passage of Spangenberg teaches these elements when it states that:

“Calculating an actual return-on-investment generally comprises determining a cost benefit of having the improvement. It may be defined as a net profit increase over a predetermined time period after implementing the improvement and then subtracting the cost of the adding the improvement. In one embodiment, a profit analysis is performed after implementing the improvement, using actual performance information of the business over a predetermined time period. This is compared to a profit analysis over a same time period length using estimated performance information, prior to implementation of the improvement. The difference in these two figures represents a net profit (or

loss) over a predetermined time period after implementing the business improvement. An actual return-on-investment can be calculated by subtracting the cost of the improvement from the net profit (or loss). In another embodiment, the net profit (or loss) is multiplied by a number equal to an expected life of the improvement divided by the predetermined time period. For example, if a profit analysis was performed using actual performance information over a predetermined time period of 6 months, and the improvement is expected to have a life of 5 years, then the net profit (or loss) over a six month period would be multiplied by 10 (5 years divided by 6 months, or half a year) to obtain a profit (or loss) over the expected life of the improvement." (Spangenberg; para. 33; Emphasis supplied)

However, among other infirmities, Applicants respectfully submit that the above passage fails to show, teach or suggest estimating benefits that are to be gained by the organization when the one or more business challenges are successfully addressed, or communicating the estimated benefits to the user, for at least two reasons. First, the claimed invention performs the claimed estimation of benefits that are to be gained by the organization when the one or more business challenges are successfully addressed prior to actually addressing the one or more business challenges. By contrast, Spangenberg performs its cost benefit retrospectively, using the "actual return-on-investment" (after implementation) and "estimated performance information, prior to implementation of the improvement" (after implementation, with regard to the outcome had the change not been implemented). This is borne out by the emphasized portions of the cited passage reproduced above, which specifically notes that these two figures are arrived at after implementing the improvement. This is reflected in the second example, which calculates the a

profit (or loss) over the expected life of the improvement is determined by multiplying the actual profit (or loss) provided the improvement at the end of a period of time by the improvement's expected lifetime. The disclosure of Spangenberg, if anything, provides only a method for making the estimations described therein (which Applicants maintain are not comparable to the claimed estimations) retrospectively.

The Office Action does not establish the presence of these limitations in Hack, SAP.com or Spangenberg, alone or in combination. Thus, Applicants respectfully submit that the Office Action fails to carry the burden of supporting a case of obviousness, including whether the prior art references teach or suggest all of the claim limitations. *See MPEP 706.02(j).*

In addition, Applicants also respectfully submit that the Office Action fails to satisfy the burden of factually supporting the alleged motivation to combine the references. Applicants respectfully submit that, as amended, even if the references showed, taught or suggested the claimed invention, that no motivation is shown, taught or suggested in the references, nor any case made therefor in the Office Action, to combine Hack, SAP.com and Spangenberg. Applicants therefore respectfully submit that amended independent claims 1, 17, 23, 26, 28 and 35 are not obvious in light of Hack, SAP.com and Spangenberg.

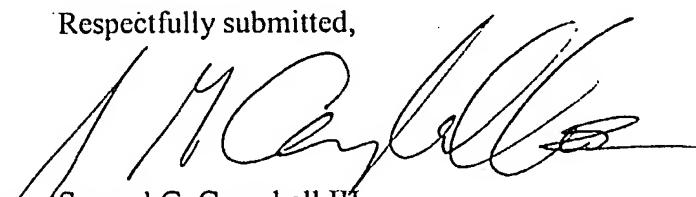
For at least the foregoing reasons, Applicants respectfully submit that amended independent claims 1, 17, 23, 26, 28 and 35 are not obvious in light of the references. Applicants further respectfully submit that amended independent claims 1, 17, 23, 26, 28 and 35, and all claims dependent upon them, are in condition for allowance. Applicants therefore request the Examiner's reconsideration of the rejections to those claims.

CONCLUSION

Applicants submit that all claims are now in condition for allowance, and an early notice to that effect is earnestly solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is requested to telephone the undersigned.

If any extensions of time under 37 C.F.R. § 1.136(a) are required in order for this submission to be considered timely, Applicant hereby petitions for such extensions. Applicant also hereby authorizes that any fees due for such extensions or any other fee associated with this submission, as specified in 37 C.F.R. § 1.16 or § 1.17, be charged to deposit account 502306.

Respectfully submitted,



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